

**REMARKS**

Claims 1-17 and 20-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent no. 6,203,433 to Kume (“Kume”) in view of U.S. Patent no. 5,963,951 to Collins (“Collins”). The rejection is respectfully traversed.

A prima facie case of obviousness requires the existence of some objective motivation or suggestion to combine the prior art references. MPEP § 2143. “The mere existence in the prior art of individual features of a patented invention does not without more invalidate the patent under the obviousness test. There must be evidence that the bringing together of such features or steps would have been obvious to an ordinarily skilled person. It is improper to combine prior art references solely because the inventor's patent itself suggests the new combination of old elements. Thus, to combine any of the teachings of the prior art there must be some teaching or suggestion supporting the combination.” *Mitsubishi Electric Corp. v. Ampex Corp.*, 51 USPQ2d 1910, 1916 (Fed. Cir. 1999). Notwithstanding such a teaching or suggestion, if the proposed “combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01. Applicant respectfully submits that it is improper to combine Kume with Collins.

Claim 1 recites an online organizing method. The method comprises, *inter alia*, “inputting an organizing request from a participant; searching personal information of participants of a plurality of terminals connected to a network; selecting the participants, who are compatible with one another, based on the personal information of the participants and the organizing request to organize selected participants; sharing information by the terminals of the organized participants; and transmitting to the respective terminals control information for carrying out a specific task.” According to claim 1, “the personal information of the participants includes a purpose for participation in said task and the organizing request includes a desired purpose.” Applicant respectfully submits that Kume fails to teach the inclusion of “a purpose for participation in said task

and [that] the organizing request includes a desired purpose.” Applicant also submits that Kume may not be combined with Collins to overcome the deficiencies of Kume, because such a combination would “change the principle of operation” of Kume.

Specifically, Kume fails to disclose a method that selects compatible participants based on personal information and an organizing request, where the information includes the participant’s purpose for the task being performed and the organizing request includes a desired purpose. Instead, Kume selects players for a game based on “the difference between the levels of two users.” Kume, col. 11, lines 37-45. Specifically, Kume creates a reference value Rx that indicates a permissible range of levels and when “the difference between the levels of two users falls within this range, the users are selected as players.” Kume, col. 11, lines 37-45. The purpose of Kume, then, is to automatically determine competitors based on player histories and game performance. A participant’s purpose or particular purpose request is not factored into the Kume game organization technique. As such, Kume fails to disclose the claimed invention.

Collins, on the other hand, teaches an online dating service wherein subscribers do submit personal preferences. Collins, col. 4, lines 50-65. The personal preferences submitted by the subscribers include a gender preference, a geographic location preference, an age preference, appearance preferences, religious belief preferences, educational level preferences and a goal preference. *Id.* The goal preference is one of “romance, friendship or a walk on the wild side.” *Id.* The purpose of Collins is “to provide an on-line dating service that provides user-controlled perusal of search results.” Collins, col. 2, lines 21-22 (emphasis added). This is in sharp contrast with Kume, where a partner is determined solely from objective criteria. In Kume, “the user is freed from efforts to find play partners by himself,” and no personal preferences are submitted. Kume, col. 13, lines 38-43. In fact, the submission of personal preferences would utterly destroy the objective purpose of the Kume player selection process. Kume provides an objective player-matching system that matches the best players together, not best friends. “This suggested combination of references would require a substantial reconstruction and redesign of the elements shown .

. . as well as a change in the basic principles under which” Kume was designed to function. *See In re Ratti*, 123 USPQ 349, 352 (CCPA 1959). Accordingly, the proposed combination is impermissible. As such, Applicant respectfully submits that Kume is not combinable with Collins in order to reject the claimed invention under 35 U.S.C. § 103(a).

For at least the foregoing reasons, Applicant respectfully submits that claim 1 is allowable over the combination of Kume and Collins. Claims 2 and 20 depend from claim 1 and are allowable along with claim 1 for at least the reasons set forth above and on their own merits.

Claim 3 recites, *inter alia*, that “the personal information of the participants includes a purpose for participation in said program and the organizing request includes a desired purpose.” Because Kume does not teach the inclusion of a purpose for participation in the personal information and organizing requests of participants, and because Kume and Collins are not combinable without changing the very principle of operation of Kume, claim 3 is allowable over the combination of Kume and Collins for at least the reasons set forth above. Claims 4 and 21 depend from claim 3 and are allowable along with claim 3 for at least the reasons set forth above and on their own merits.

Claim 5 recites, *inter alia*, “organizing means for, based on personal information of participants of a plurality of terminals connected to a network and an organizing request from at least one of the participants, selecting the participants, who are compatible with one another, to organize the selected participants, said personal information including a participant purpose and the organizing request includes a desired purpose.” Because Kume does not teach the inclusion of a purpose for participation in the personal information and organizing requests of participants, and because Kume and Collins are not combinable without changing the very principle of operation of Kume, claim 5 is allowable over the cited combination for at least the reasons set forth above.

Claims 6-11 and 22 depend from claim 5 and are allowable along with claim 5 for at least the reasons set forth above and on their own merits.

Claim 12 recites a “terminal device transmitting personal information of a user to the server; sharing information through the server among the rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific task.” According to claim 12, “the personal information includes a user purpose for the task.” Because Kume does not teach the inclusion of a purpose for participation in the personal information of the participants, and because Kume and Collins are not combinable without changing the very principle of operation of Kume, Applicant respectfully submits that claim 12 is allowable over the combination of Kume and Collins for at least the reasons set forth above. Claims 13, 14 and 23 depend from claim 12 and are allowable along with claim 12 for at least the reasons set forth above and on their own merits.

Claim 15 recites, *inter alia*, that “the personal information includes a user purpose for the task and said transmitting step occurs in response to a user request that includes a desired purpose.” Kume does not teach the inclusion of a purpose for participation in the personal information and organizing requests of participants. Additionally, Kume and Collins are not combinable without changing the very principle of operation of Kume. As such, claim 15 is allowable over the combination of Kume and Collins for at least the reasons set forth above. Claim 24 depends on claim 15 and is allowable along with claim 15 for at least the reasons set forth above and on its own merits.

Claim 16 recites, *inter alia*, that “the personal information of the participants includes a purpose for participation in said task and the organizing request includes a desired purpose.” Because Kume does not teach the inclusion of a purpose for participation in the personal information and organizing requests of participants, and because Kume and Collins are not combinable without changing the very principle of operation of Kume, Applicant respectfully submits that claim 16 is allowable over the combination of Kume and Collins for at least the reasons set forth above.

Claim 17 recites, *inter alia*, that “the personal information includes a user purpose for the task.” Because Kume does not teach the inclusion of a purpose for participation in the personal information of participants, and because Kume and Collins are not combinable without changing the very principle of operation of Kume, Applicant respectfully submits that claim 17 is allowable over the combination of Kume and Collins for at least the reasons set forth above.

Accordingly, Applicant respectfully requests that the rejection be withdrawn and claims 1-17 and 20-24 allowed.

Claims 1-17 and 20-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent no. 6,352,479 to Sparks, II (“Sparks”) in view of U.S. Patent no. 6,547,568 to Yamano (“Yamano”). The rejection is respectfully traversed.

Applicant respectfully notes that Yamano is not valid prior art under 35 U.S.C. § 103(a). Yamano’s effective date does not predate the priority date of the present invention. Yamano’s effective date is Oct. 12, 2000. The effective priority date for the present application is Mar. 30, 2000. *See* Final Office Action, p. 2. As such, it is improper to rely on Yamano in the 35 U.S.C. § 103(a) rejection.

Claim 1 recites an online organizing method. The method comprises “inputting an organizing request from a participant; searching personal information of participants of a plurality of terminals connected to a network, said personal information accessible via visual memory devices connected to said plurality of terminals; selecting the participants, who are compatible with one another, based on the personal information of the participants and the organizing request to organize selected participants; sharing information by the terminals of the organized participants; and transmitting to the respective terminals control information for carrying out a specific task.” According to claim 1, “the personal information of the participants includes a purpose for participation in said task and the organizing request includes a desired purpose.” Applicant respectfully submits that Sparks fails to disclose the claimed invention.

Specifically, Sparks fails to disclose a method that selects compatible participants based on personal information and an organizing request, where the information includes the participant's purpose for the task being performed and the organizing request includes a desired purpose. Instead, Sparks selects players for a game based on statistics, a user's skill level and undisclosed user preferences. That is, the Sparks server "loads the user's game play statistics and preferences from the HDD 36 . . . and determines from the game play statistics the user's relative skill level for each one of the possible games to which the user could be matched. This determination is made by comparing the user's relative successes during previous attempts at playing each game." Sparks Col 6. , line 55-61. Although Sparks mentions user preferences, there is no disclosure whatsoever of personal information or a request containing a preferred purpose for the task being carried out. That is, a participant's purpose or particular purpose request is not factored into the Sparks game organization technique.

For at least the foregoing reasons, Applicant respectfully submits that claim 1 is allowable over the cited combination. Claims 2 and 20 depend from claim 1 and are allowable along with claim 1 for at least the reasons set forth above and on their own merits.

Claim 3 recites, *inter alia*, that "the personal information of the participants includes a purpose for participation in said program and the organizing request includes a desired purpose." Because Sparks does not teach the disclosure of personal information containing a purpose and because Yamano is not prior art, claim 3 is allowable over the cited combination for at least the reasons set forth above. Claims 4 and 21 depend from claim 3 and are allowable along with claim 3 for at least the reasons set forth above and on their own merits.

Claim 5 recites, *inter alia*, "organizing means for, based on personal information of participants of a plurality of terminals connected to a network and an organizing request from at least one of the participants, selecting the participants, who are compatible with one another, to organize the selected participants, said personal

information including a participant purpose and the organizing request includes a desired purpose.” Because Sparks does not teach the disclosure of personal information containing a purpose and because Yamano is not prior art, claim 5 is allowable over the cited combination for at least the reasons set forth above. Claims 6-11 and 22 depend from claim 5 and are allowable along with claim 5 for at least the reasons set forth above and on their own merits.

Claim 12 recites a “terminal device transmitting personal information of a user to the server; sharing information through the server among the rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific task.” According to claim 12, “the personal information includes a user purpose for the task.” Applicant respectfully submits that claim 12 is allowable over the combination of Sparks and Yamano for at least the reasons set forth above. Claims 13, 14 and 22 depend from claim 12 and are allowable along with claim 12 for at least the reasons set forth above and on their own merits.

Claim 15 recites, *inter alia*, that “the personal information includes a user purpose for the task and said transmitting step occurs in response to a user request that includes a desired purpose.” Because Sparks does not teach the disclosure of personal information containing a purpose and because Yamano is not prior art, claims 15 is allowable over the cited combination for at least the reasons set forth above. Claim 24 depends from claim 15 and is allowable along with claim 15 for at least the reasons set forth above and on its own merits.

Claim 16 recites “inputting an organizing request from a participant, searching personal information of the participants of a plurality of terminals connected to a network,” and “selecting the participants, who are compatible with one another, based on the personal information of the participants and the organizing request; ... wherein the personal information of the participants includes a purpose for participation in said task and the organizing request includes a desired purpose.” Applicant respectfully submits that

claim 16 is allowable over the combination of Sparks and Yamano for at least the reasons set forth above.

Claim 17 recites “transmitting to a server personal information of users based on a user request; . . . wherein the personal information includes a user purpose for the task.” Applicant respectfully submits that claim 17 is allowable over the combination of Sparks and Yamano for at least the reasons set forth above.

Accordingly, Applicant respectfully requests that the rejection be withdrawn and claims 1-17 and 20-24 allowed.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: May 13, 2005

Respectfully submitted,

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